

REMARKS/ARGUMENTS

Claims 1-51 were pending in the application and examined.

Applicant has amended claims 1-3, 8-14, 16-20, 25-31, and 33-51. Applicant submits that no new subject matter has been introduced by the amendments. Claims 1-51 remain pending in this application after entry of this amendment.

THE SPECIFICATION

The specification has been amended to update information related to an application incorporated by reference and to correct inadvertently introduced typographical errors. Applicant submits that no new subject matter has been introduced by the amendments.

THE CLAIMS

Claims 1-51 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Chiu et al (U.S. Patent No. 6,452,615) (hereinafter "Chiu") and King et al (U.S. Patent No. 6,721,288) (hereinafter "King").

Claim 1

Applicant submits that claim 1 is patentable over a combination of Chiu and King for at least the reasons stated below.

In addition to other features, claim 1 recites:

generating a first request at the note-taking device to insert a first portion of a first information in a first location in the notes document, the first information comprising information captured by one or more capture devices; (Applicant's claim 1, in part, emphasis added).

As recited above in claim 1, the request generated at the note-taking device is for a portion of the captured information to be inserted into a location (*first location*) in the notes document. For example, a request may be made to insert a portion of video information into the notes document. This is to be differentiated from merely requesting insertion of a hyperlink or index to the captured information into the notes document. Applicant submits that this feature of claim 1 is not taught or suggested by Chiu.

The Office Action asserts that the above-discussed feature of claim 1 is taught by Chiu in col. 6 lines 6-28, request processing of Fig. 5 in Chiu, and system overview in Fig. 8 of Chiu. Applicant respectfully disagrees.

Chiu describes a notetaking device that enables media input streams to be retrieved for playback. Facilities provided by the notetaking device allow a user to capture stills from the media streams, make annotations, and reference important events that occur during a notetaking session. Thumbnails, snaps, and backgrounds may be created from the input media streams and are used to reference into the media streams which are stored for later playback. (Chiu: Abstract).

Applicant submits that the thumbnails, snaps, and background created in Chiu are indexes into media streams that are separately stored. There appears to be no teaching in Chiu that a portion of the media stream (e.g., a portion of the video information) -- not just an index to the media stream -- is stored in the notes document (note file) of Chiu. Applicant thus submits that the notetaking device in Chiu only enables a user to create indexes to the stored media information. This is however different from requesting insertion of a portion of the captured information into the notes document. As recited in claim 1 and discussed above, the "request" recited in claim 1 is for a portion of the captured information to be inserted into a location in the notes document -- not for merely creating an index to the stored information.

The sections of Chiu cited by the Office Action in rejecting this feature of claim 1 further make evident that Chiu merely teaches creation of indexes in a note file. Fig. 5 and the accompanying description in col. 6 lines 6-28 of Chiu describe that the note file produced in Chiu consists of digital ink strokes, thumbnails, and background snaps. These objects are time stamped and attributed with a channel number, which provides indexes into the video streams. (Chiu: col. 6 lines 23-27). Several other sections of Chiu (e.g., Chiu: col. 4 lines 44-46; Fig. 7) also describe that the thumbnails and snaps are merely indexes -- there appears to be no teaching about requests to insert a portion of the video information into the notes file.

Accordingly, Applicant submits that the request recited in claim 1 is very different from what a person can request using the notetaking device in Chiu. In claim 1, the request is to insert a portion of the captured information into the notes document. Whereas, in

Chiu, the user can request that an index (e.g., thumbnail, snap) be created that references the video information -- unlike claim 1, Chiu does not teach a request for inserting a portion of the video into the notes document. Applicant thus submits that the "*generating . . .*" feature recited in claim 1 is not taught or suggested by Chiu.

Further, claim 1 recites "*determining if the first request can be processed*". Accordingly, claim 1 specifically recites that a determination is made if the request can be processed. Applicant submits that this is not taught or suggested by Chiu. The Office Action asserts that this feature of claim 1 is taught by Chiu in col. 6 lines 28-34 and lines 50-54. Applicant respectfully disagrees.

Col. 6 lines 28-34 of Chiu describe what is stored in a note file created in Chiu. As described in this section, the note file references objects such as thumbnails, ink strokes, and snaps, and other information. Each object has a corresponding time stamp and a channel identifier. Col. 6 lines 50-54 of Chiu describe that the video streams (that are indexed by the objects in a note file) may be stored separately on a server on a network or may be stored locally with the note files. Applicant submits that neither of these sections of Chiu however teaches anything about determining if a request can be processed or not, as recited in claim 1. Applicant submits that Chiu is not concerned and silent about whether a request (such as a request to create an object in a notes file) can be processed or not -- it assumes that whenever a user requests a thumbnail or snap to be created, that request is fulfilled. There appears to be no discussion in Chiu of determining whether a request can be processed, as recited in Applicant's claim 1. Applicant thus submits that the "*determining . . .*" feature recited in claim 1 is also not taught or suggested by Chiu.

The Office Action acknowledges that the "*storing . . .*" feature recited in claim 1 is not taught or suggested by Chiu (Office Action: page 3). However, the Office Action asserts that this feature is taught by King in the abstract, col. 6 lines 10-32, and col. 6 line 56 to col. 7 line 6. Applicant respectfully disagrees.

King teaches improved techniques for reducing delays faced by users of mobile devices due to unavailability of wireless networks. The techniques include a first technique that allows mobile devices to communicate with remote servers using asynchronous communications,

namely asynchronous requests. Such asynchronous communications allow the processing at a mobile device to continue while the asynchronous request is processed in the background. A second technique pertains to the use of content channels with mobile devices. The content channels are stored and retained in cache memory so that their resources are guaranteed to be locally available, regardless of availability of wireless networks. A third technique pertains to improved list processing within mobile devices such that lists can be manipulated without server interaction. These various techniques can be used separately or in combination. (King: Abstract).

Col. 6 lines 10-32 of King reiterate the different techniques (asynchronous requests, caching content channels, improved list processing) used for reducing delays. Col. 6 line 56 to col. 7 line 6 of King describes functions performed by a synchronous requests manager and an asynchronous message manager. However, Applicant submits that these sections of King fail to teach or disclose anything about storing a request in a notes document using a note-taking taking device, as recited in claim 1. Applicant would like to point out that claim 1 recites storing a specific type of request (namely, a request generated at the note-taking device and requesting insertion of a portion of captured information in a location in the notes document) in a specific location (namely, in a location in the notes document). Applicant submits that these features of the "*storing . . .*" step recited in claim 1 are not taught or suggested by King.

The sections of King recited in the Office Action merely teach about asynchronous requests that allow processing at a mobile communication device to continue while the asynchronous request is processed in the background. There is no teaching however that the request is the same as or similar to the request recited in claim 1. Further, the sections of King cited in the Office Action teach that content channels are stored and retained in cache memory so that their resources are guaranteed to be locally available, regardless of availability of wireless networks. King however does not appear to teach or suggest anything about storing a request in a notes document, as recited in claim 1. Merely using asynchronous requests and caching content channels does not teach or suggest anything about storing a request in a notes document, as recited in claim 1. Applicant thus submits that the "*storing . . .*" feature of claim 1 is not taught or suggested by King.

Applicant further submits that King also fails to teach or suggest the "*generating . . .*" and "*determining . . .*" features recited in claim 1. In light of the above, Applicant submits that the deficiencies of Chiu are not cured by King. Accordingly, even if Chiu and King were combined as suggested by the Office Action (even though there appears to be no motivation for the combination), Applicant submits that the resultant combination would not make obvious the invention recited in claim 1.

Applicant thus submits that claim 1 is patentable over a combination of Chiu and King for at least the reasons discussed above, in addition to others.

Claims 2-51

Applicant submits that independent claims 18 and 35 are allowable over a combination of Chiu and King for at least a similar rationale as discussed above for the allowability of claim 1, and others.

Applicant further submits that dependent claims 2-17, 19-34, and 36-51 that depend either directly or indirectly from claims 1, 18, and 35, respectively, are allowable over a combination of Chiu and King for at least a similar rationale as discussed above for the allowability of the independent claims.

Furthermore, the dependent claims recite additional features which make them patentable for additional reasons. For example, claims 8, 11, 17, 25, 28, 34, 42, 45, and 51 specifically recite inserting the requested portion of the captured information into the notes document. This is to be differentiated from merely inserting hyperlinks or indexes to the stored information. For example, as described in Applicant's specification

. . . the inserted data is actually embedded in the notes document--this is substantially different from hyperlinks that provide links to data. As a result, various operations that can ordinarily be performed on a document can be performed on the notes document. For example, the document can be copied, distributed, etc. (Applicant's specification, paragraph [0063])

As previously discussed, in Chiu, only indexes to the captured information are stored in the notes file -- there is no teaching in Chiu that a portion of the video information is inserted into the note file. Further, this deficiency of Chiu is not cured by King. There is no

teaching in King of inserting portions of captured information into a notes document. Accordingly, Applicant submits that claims 8, 11, 17, 25, 28, 34, 42, 45, and 51 are allowable over a combination of Chiu and King for this additional reason.

Further, claims 15, 32, and 49 recite inserting a visual marker in the first location in the notes document indicative of the first request. Applicant submits that this feature is not taught by Chiu or King. The Office Action asserts that Chiu teaches this feature in Fig. 7 of Chiu. Applicant respectfully disagree. Fig. 7 of Chiu illustrates an implementation of a note file that references any one of the objects or items 700 input by the NoteLook 100 (thumbnail 710, ink strokes 715, and snap 720, for example). Each object has a corresponding timestamp 750 and channel identifier 770. The thumbnails, ink strokes, and snaps in Chiu are merely indexes to the stored video information and not visual markers indicative of a request as recited in claims 15, 32, and 49. Further, the Office Action acknowledges that Chiu fails to teach anything about storing a request in a notes document. Since Chiu does not teach storing of requests in a notes document, Applicant submits that Chiu cannot and does not teach anything about inserting a visual marker in a location in the notes document indicative of the request, as recited in claims 15, 32, and 49. Applicant thus submits that claims 15, 32, and 49 are allowable over a combination of Chiu and King for this additional reason.

Claim amendments not for reasons of patentability

Applicant has amended the claims to change all instances of "*first portion*" to "*portion*". Applicant submits that these amendments have been made solely to improve readability of the claims and have not been made for reasons of patentability.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

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Reply to Office Action of June 22, 2007

PATENT

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 650-326-2400.

Respectfully submitted,

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